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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,778	11/10/2003	Satoshi Mizutani	20050/0200475-US0	4391

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT PAPER NUMBER

3761

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/705,778

Applicant(s)

MIZUTANI ET AL.

Examiner

Jacqueline F. Stephens

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7 and 9-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 4/25/06 have been fully considered but they are not persuasive. Applicant argues the Wierlacher invention does not teach or suggest the mini-sheet bonded at a peripheral edge to one end of the backsheet of the interlabial pad. However, Figures 5b, 8, and 9 show the minisheet bonded at its peripheral edge to one end (side end) of the backsheet. As to claim 5, Applicant argues Wierlacher does not teach the minisheet formed from a pair of flap portions as claimed and that Wierlacher is a single strip. However, a 'pair of flap portions' does not denote two separate strips. The Wierlacher invention has a flap portion on the left and a flap portion on the right, which constitutes a pair of flap portions as claimed.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 11, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/01093 to Wierlacher.

As to claims 1, 6, 11, and 12, Weirlacher discloses a pad capable of being used as an interlabial pad having a mini sheet 62 (Figure 5b). The cavity for the finger insertion is considered to be at the angle of deflection (Figure 5b). The mini sheet is capable of covering a portion of the finger application point – which has not been defined by applicant, therefore, any point on the napkin is capable of being the finger application point. Figures 5b, 8, and 9 show the minisheet bonded at its peripheral edge to one end (side end) of the backsheet.

As to claim 4, see page 22, paragraph 2.

4. As to claim 5, Weirlacher discloses a pad capable of being used as an interlabial pad having an elongated shape and a surface sheet, backsheet, and absorbent core (Abstract) and a mini sheet 62 (Figure 5b). The cavity for the finger insertion is considered to be at the angle of deflection (Figure 5b). The mini sheet is capable of covering a portion of the finger application point – which has not been defined by applicant, therefore, any point on the napkin is capable of being the finger application point. The examiner interprets the limitation of a 'pair of flap portions' as not requiring two separate strips. Figure shows a flap portion on the left and a flap portion on the right, which constitutes a pair of flap portions as broadly as claimed.

As to claims 15 and 16, the limitations are directed to an intended use of the article. "Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

As to claim 17, see page 27, paragraph 5 and page 28, paragraph 2.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/01093 to Wierlacher. Wierlacher discloses the present invention substantially as claimed. However Wierlacher does not disclose the claimed dimensions of the article. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/01093 to Wierlacher in view of Osborn WO 98/08475. Wierlacher discloses the present invention substantially as claimed. However Wierlacher does not disclose the article is biodegradable. Osborn discloses a biodegradable interlabial pad for the benefit of being able to dispose of the pad in a conventional toilet without causing disposal problems (page 1, paragraph 1). It would have been obvious to modify Wierlacher to be biodegradable for the benefits disclosed in Osborn.

9. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weirlacher in view of Sisson USPN 3989867. Weirlacher discloses the present invention substantially as claimed. However, Wierlacher is silent as to the moisture permeability of the backsheet. Sisson discloses an absorbent article having a

breathable backsheet may be provided by providing bosses on the backsheet (Figures 1 and 3).  
Sisson discloses the apertured backsheet provides the benefit of being liquid impervious and moisture permeable to allow water vapor formed within the absorptive device by human body heat to escape through the pores (col. 2, lines 14-27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the backsheet of Wierlacher with bosses for the benefits taught by Sisson.

### ***Conclusion***


10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jacqueline F Stephens  
Primary Examiner  
Art Unit 3761

July 10, 2006